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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,290	10/19/2005	Tracey A. Cavato	38-21(52221)B	5924
27161	7590	12/27/2007		
MONSANTO COMPANY 800 N. LINDBERGH BLVD. ATTENTION: GAIL P. WUELLNER, IP PARALEGAL, (E2NA) ST. LOUIS, MO 63167			EXAMINER KUBELIK, ANNE R	
			ART UNIT	PAPER NUMBER
			1638	
			MAIL DATE	DELIVERY MODE
			12/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/523,290	Applicant(s) CAVATO ET AL.	
	Examiner Anne R. Kubelik	Art Unit 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-31 and 43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-31 and 43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 21-31 and 43 are pending.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. The objection to claims 21, 23-26 and 28 because of informalities is withdrawn in light of Applicant's amendment to the claims.
4. The objection to claims 24 and 28 under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim is withdrawn in light of Applicant's amendment to the claims.
5. The objection to claim 30 under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim is withdrawn in light of Applicant's amendment to the claims.
6. The rejection of claims 21-31 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement is withdrawn in light of Applicant's deposit statement filed 18 October 2007.
7. The rejection of claims 23 and 28 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention is withdrawn in light of Applicant's amendment to the claims.
8. The rejection of claims 24 and 28 under 35 U.S.C. 102(b) as being anticipated by Vattikonda (2000, US Patent 6,137,038) is withdrawn in light of Applicant's amendment to the claims.

Claim Rejections - 35 USC § 102

9. Claims 21-22, 29-31 and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by Pershing et al (2003, US Patent 6,551,962). The rejection is repeated for the reasons of record as set forth in the Office action mailed 18 July 2007, as applied to claims 21-22 and 29-31.

Applicant's arguments filed 18 October 2007 have been fully considered but they are not persuasive.

Pershing et al discloses corn event MON863 plants and seeds (column 24, lines 30-37 and column 24, line 62, to column 25, line 7). The seeds are biological samples of the plant, and the plant is a biological sample of itself.

Applicant urges that the disclosure of Pershing was based on information obtained from the instant inventors (response pg 8).

This is not found persuasive. The applied reference has a common assignee with the instant application. This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Applicant urges that Pershing is not enabled for the MON863 event, as evidenced by the instant despot requirement (response pg 8-9).

This is not found persuasive because Applicant has provided no evidence that MON863 was not available. The enablement rejection could have been overcome by pointing out availability rather than making a deposit. A *prima facie* rejection is not evidence that can be used to overcome a different rejection.

Claim Rejections - 35 USC § 103

10. Claims 21-31 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pershing et al (2003, US Patent 6,551,962). The rejection is repeated for the reasons of record as set forth in the Office action mailed 18 July 2007, as applied to claims 21-31. Applicant's arguments filed 18 October 2007 have been fully considered but they are not persuasive.

The claims are drawn to biological samples and extracts of MON863.

The teachings of Pershing et al are discussed above. Pershing et al do not disclose extracts from MON863.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to prepare extracts from the corn event MON863 plants taught by Pershing et al. One of ordinary skill in the art would have been motivated to do so because corn flour, meal, syrup, oil, starch and cereals are economically important products produced from corn,

Applicant urges that Pershing was not published prior to the effective filing date of the instant application (response pg 9).

This is not found persuasive because 102(e) type references, as far as dates go, are prior art under 35 USC 103.

Conclusion

11. No claim is allowed.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne R. Kubelik, whose telephone number is (571) 272-0801. The examiner can normally be reached Monday through Friday, 8:30 am - 5:00 pm.

Art Unit: 1638

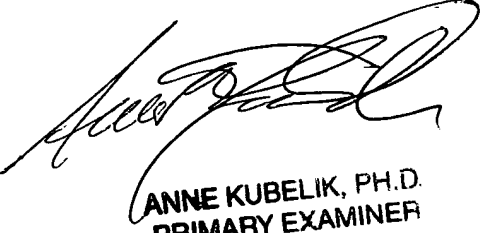
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg, can be reached at (571) 272-0975.

The central fax number for official correspondence is (571) 273-8300.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Anne Kubelik, Ph.D.
December 18, 2007



**ANNE KUBELIK, PH.D.
PRIMARY EXAMINER**